

REMARKS

Claims 1-9 are pending. By this Amendment, the title and claims 1, 4, 6 and 9 are amended. Further, an Abstract has been provided. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

In paragraph 1, the Office Action indicates that an Abstract is required. An Abstract is provided on the attached separate page.

In paragraph 2, claims 6 and 9 were objected to as depending from multiple dependent claims. Claims 6 and 9, as well as claim 4, have been amended to depend from claim 1 only.

Claims 1, 2, 5, 7 and 8 (and apparently claim 6) were rejected under 35 U.S.C. §103(a) over Thompson. This rejection is respectfully traversed.

Applicant respectfully submits that the a *prima facie* case of obviousness has not been established. In order to make a proper *prima facie* case of obviousness based on Thompson, the it must shown that Thompson discloses or reasonably suggests each and every feature of the claims.

First, claim 1 recites a “thin flexible membrane.” Nothing in the Office Action addresses the word “flexible”. The element which the Office Action identifies as the “enclosure” is the air blower A, as seen in Figure 4. However, the air blower A is not described as flexible. Nor has the Office Action indicated that there is any reason to make the blower A flexible, as claimed. For this reason alone, the rejection should be withdrawn.

Second, the Examiner admits that “Thompson fails to teach a *thin* flexible enclosure”. (Emphasis added.) To make up for this deficiency, the Examiner asserts

that it would have been obvious to one of ordinary skill in the art to make the “enclosure” of Thompson thin because:

... the dimensions of the enclosure is (*sic*) a mere design choice and that (*sic*) any dimension would perform equally as well. Furthermore, the applicant has not disclosed that the specific type of dimensions solves (*sic*) any stated problems or is (*sic*) for any particular purpose and it appears that the invention would perform equally well (*sic*) the dimensions taught by Thompson.

See the paragraph bridging pages 2 and 3 of the Office Action.

As best understood, it appears that the Examiner concludes that the claimed dimension (e.g., a “thin” flexible enclosure) is a “mere design choice” because: 1) any dimension would perform equally as well as the claimed thin enclosure; 2) Applicant has not disclosed that the thin flexible enclosure solves any stated problems; and/or 3) it appears that Thompson’s dimensions would perform equally as well as the thin flexible enclosure.

With respect to points 1) and 3), the Examiner offers no evidence that “any” dimension would work as well as the claimed thin flexible enclosure, or that the device of Thompson would work as well as the claimed thin flexible enclosure. The Examiner’s statements are simply bald conclusory assertions having no foundation.

With respect to point 2), Applicant notes that the claimed “thin flexible membrane” has certain advantages described on pages 4 and 5 of the specification. In particular, the recited thin flexible enclosure has the following advantages:

(1) simple and inexpensive noise reduction – one of ordinary skill in the art would not have appreciated that this simple and inexpensive technique would have been successful – e.g., a skilled artisan would not have expected that thinning of the Thompson “enclosure” (blower A) would have been successful especially as Thompson does not recognize noise as a problem;

(2) the claimed thin flexible membrane reduces noise by approximately 2dBA compared to a CPAP apparatus without a thin flexible enclosure;

(3) installation and replacement of the thin flexible enclosure is made easier; and/or

(4) sterilization of the apparatus is easier, as the components of the apparatus through which air is drawn are effectively isolated from other components, such as electrical circuitry.

In addition to not disclosing the features recited in claim 1, Thompson does not disclose or suggest any or all of the advantages provided by those features, and Applicant strongly disagrees with the Examiner's assertion that they would have been matters of "mere design choice." Moreover, the Court of Appeals for the Federal Circuit, in In re Chu, 36 USPQ2d 1089, 1095, stated that:

From the totality of the record, we hold that placement of the SCR catalyst within the bag retainer would not have been merely a matter of 'design choice.' First, there is no teaching or suggestion in the prior art that would lead one of ordinary skill in the art to modify the Szymanski structure to place the SCR catalyst within a bag retainer as opposed to between two filter bags as disclosed in Szymanski. Next, Chu's technical evidence relating to the frailty of fabric filters during pulse-jet cleaning clearly counters the assertion that placement of the catalyst in the baghouse is merely a 'design choice.'

Applicant submits that the principles of the In re Chu decision apply here, because the Thompson reference does not teach or suggest the features of the claims and because the claimed thin flexible enclosure provides advantages that are not disclosed in or suggested by Thompson. The advantages are described in detail in the specification, and are repeated above for the Examiner's consideration. Stated otherwise, Applicant respectfully submits that the Examiner's proposed motivation to modify Thompson is pure, impermissible hindsight.

Moreover, although Applicant has already done so, it is not necessary for Applicant to show that the claimed thin flexible enclosure produces an unexpected result or unexpectedly resolves a new problem. In this context, the Examiner is requested to consider the following case law. In particular, an invention that does achieve an effect greater or that produced unusual or surprising results could of course be viewed to have been non-obvious in light of those facts. Evidence of such achievements, like evidence of meeting a long felt need, commercial success, overcoming disbelief, etc., may when present support a conclusion of nonobviousness. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1540, (Fed. Cir. 1983). "Absence of such evidence, on the other hand, does not dictate a conclusion of obviousness." (Emphasis added.) Further, see In re Bertin, 139 USPQ 275, 277 (CCPA 1963), wherein the Court held:

The requirement of claim 19 that 'within each zone the nozzles are arranged along part of a helix' is not shown in any of the references. The Board stated that it found no evidence of criticality in the recited arrangement and concluded on that basis that such arrangement involves merely one of arbitrary choice. In the absence of any suggestion of a helical arrangement of the nozzles in the prior art, however, we are unable to conclude that the recited arrangement is obvious.

In the present context, not only does Thompson not show the claimed thin flexible enclosure, but the thin flexible enclosure is described in the specification as having several advantages.

Dependent claims 2, 5-7 and 8 are patentable by virtue of their dependence on independent claim 1, in addition to their recitation of additional patentable subject matter. For example, as to claims 2 and 5, the Office Action takes the position that it is well known in the respirator art to use plastic for producing enclosures (claim 2) and that Thompson's snug fit and the use of the claimed tape are "mechanical expedients" (claim 5). In accordance with MPEP §2144.03, the Examiner is

requested to produce reference(s) teaching these features so that Applicant may assess their teachings and whether they are combinable with Thompson.

Further, claim 7 specifies that the noise producing components include a blower, an inlet muffler and an outlet muffler, all of which (per claim 1) must be within the thin flexible enclosure. However, Thompson teaches that the outlet muffler F is outside the “enclosure” A (the blower of Thompson).

For at least the above reasons, Applicant submits that the rejection is improper and should be withdrawn.


Claim 3 was rejected under 35 U.S.C. §103(a) over Thompson in view of MacGregor. However, there is no motivation to combine MacGregor (an underwater device) with Thompson, and claim 3 depends from allowable claim 1. Withdrawal of the rejection is respectfully requested.

In view of the above amendments and remarks, Applicant submits that all the claims are patentable and that the entire application is in condition for allowance. A Notice to that effect is earnestly solicited. If questions relating to patentability remain, the Examiner is invited to contact the undersigned to discuss the same.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached Appendix is captioned **“Version with markings to show changes made”**.

Respectfully submitted,

PILLSBURY WINTHROP LLP

By 
Paul T. Bowen
Reg. No. 38,009
Tel. No.: (202) 861-3014
Fax No.: (202) 822-0944

PTB/jck
Enclosure:
Abstract
Appendix

P.O. Box 10500
McLean, VA, 22102
(703) 905-2000

APPENDIX

IN THE TITLE:

The title has been changed as indicated above.

IN THE ABSTRACT:

An Abstract has been provided.

IN THE CLAIMS:

Claims 1, 4, 6 and 9 have been amended as follows:

1. (Amended) An apparatus for supplying breathable gas, the apparatus including:

a relatively rigid external housing;

at least one noise producing component internal to the housing; and

a thin flexible enclosure substantially sealed around [the] each said noise producing [component(s)] component.

4. (Amended) The apparatus as claimed in [any one of the preceding claims] claim 1, wherein the flexible enclosure includes an opening adapted to allow passage of [the] each said internal [component(s)] component into the interior of the flexible enclosure.

6. (Amended) The apparatus as claimed in [any one of the preceding claims] claim 1, wherein the flexible enclosure includes one or more apertures to allow breathable gas into and out of [the] each said noise producing [component(s)] component.

9. (Amended) A method of assembling the apparatus claimed in [any one of the preceding claims] claim 1, the method comprising [the steps of]:

[assembling the] providing the at least one noise producing [component(s) into] component in a sub-assembly;

placing the sub-assembly into the interior of the [thin] flexible enclosure through an opening therein;

substantially sealing the opening; and

placing the flexible enclosure within the external housing.